

Response Under 37 C.F.R. § 1.111
U.S. Appln. No. 09/895,195

REMARKS

Claims 25-37 and 39-41 are pending in the present application. For at least the following reasons, Applicant respectfully requests withdrawal of the rejection, and allowance of the claims.

I. Claims 37-41 are novel

Claims 37-41 stand rejected due to alleged anticipation under 35 U.S.C. § 102(b) over McCole (U.S. Patent No. 4,312,939).¹ Applicant respectfully submits that McCole fails to disclose all of the claimed features, as required for an anticipation rejection. For at least the reasons herein, Applicant respectfully requests withdrawal of the rejection, and allowance of the claims.

McCole discloses a photographic product and process of making the same, similar to application related art Figure 11. McCole only feeds the continuous member single pitches at a time, and thus encounters the problems discussed at application pages 2-4. Accordingly, it is submitted that McCole does not disclose or suggest feeding a plurality of pitches at a time to a bonding station.

While the Examiner directs Applicant to column 5, lines 39-46 and 66-68 and column 6, lines 1-7, Applicant respectfully submits that these citations do not disclose feeding a plurality of pitches at a time. More specifically, Applicant notes that the predetermined increment is actually the width of a subassembly comprising portions of the sheets 1, 3 in the finished film unit.

¹ On page 3 of the Office Action, the Examiner discusses the a rejection associated with claim 38. However, Applicant notes that claim 38 has been cancelled previously, and thus should not have been rejected in the present Office Action.

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Accordingly, Applicant respectfully submits that there is no disclosure or suggestion that the predetermined increment encompasses a plurality of pitch increments.

Additionally, while the Examiner has directed Applicant to column 4, lines 9-14 of McCole, Applicant has not found any disclosure of feeding a plurality of pitches at a time to a bonding station. In fact, that particular citation of McCole only discloses that a sheet 1 is bonded to another sheet 3, and is not at all directed to the rate of feeding of the sheets to the processing mechanism. Applicant respectfully submits that McCole does not disclose or suggest feeding a plurality of pitches at a time to a bonding station, and cutting the sheets after bonding.

Applicant respectfully submits that McCole fails to disclose all of the claimed combinations of features recited in claims 37 and 39-41. For example, but not by way of limitation, Applicant respectfully submits that McCole fails to disclose that the component supply station includes means for supplying the mask sheet and the two sheets as first through third continuous members, the arrangement being such that the first through third continuous members are cut together after being bonded to each other, and wherein said first through third members are fed a plurality of pitches at a time at least at said bonding station, as recited in independent claim 37.

Applicant respectfully submits that McCole does not disclose the aforementioned claimed feature, and as a result, suffers the related art problems (e.g., undesirable idle times) disclosed at application pages 2-4. More specifically, McCole only feeds its members a single pitch at a time. Further, Applicant respectfully submits that it would not be possible for McCole to feed a plurality of pitches at a time, because the cutter would not be able to cut each unit separately.

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Claims 39-41 depend from independent claim 37. Applicant respectfully submits that the dependent claims are allowable for at least the same reasons as the independent claim from which they depend. Additionally, Applicant respectfully submits that McCole fails to disclose a beveling station for beveling corners of said instant photography film unit, as recited in dependent claim 39, according to “beveling” as would have been understood by one of ordinary skill in the art at the time of the invention.

Applicant respectfully disagrees with the Examiner’s interpretation of reference character 25 (i.e., perimeter sealing station) of McCole as a beveling station. Applicant respectfully submits that one skilled in the art would not have characterized a perimeter sealing station as a beveling station.

II. Claims 25-36 would not have been obvious

Claims 25-29 stand rejected due to alleged obviousness under 35 U.S.C. § 103(a) over the Examiner’s proposed combination of McCole in view of Arima (U.S. Patent No. 4,944,503), and claims 30-36 stand rejected under § 103(a) over the Examiner’s proposed combination of McCole in view of newly cited Shimizu et al. (U.S. Patent No. 6,141,852, hereafter “Shimizu”).

A. Claims 25-29

Arima discloses a division sheet feeding apparatus. As illustrated in Figure 1 of Arima, a web cutting means 2 cuts a product into sheets, which are conveyed by a product sheet conveyance means 3, and then stacked on top of one another at a stacking station. As illustrated in Figure 3 of Arima, division sheets 10 are positioned between the stacks 9 of sheets. However, Applicant respectfully submits that Arima does not disclose a packaging station, where stacked

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film units are automatically housed into a film pack. Examiner asserts that column 1, lines 14-19 of Arima discloses packaging sheets cut into continuous length. However, Applicant respectfully submits that in the absence of the Applicant's own specification supporting the presently claimed invention, Arima does not disclose or suggest a packaging station, where stacked film units are automatically housed into a film pack.

Applicant respectfully submits that the Examiner's proposed combination of references fails to disclose or suggest all of the claimed combination of features. For example, but not by way of limitation, Applicant respectfully submits that the proposed combination of McCole and Arima fails to disclose or suggest a packaging station for automatically housing the stacked instant photography film units into a film pack, as recited in independent claim 25. As acknowledged by the Examiner, McCole fails to disclose or suggest this claimed feature.

Applicant respectfully submits that the proposed combination of Arima into McCole fails to cure this acknowledged deficiency of McCole. For example, but not by way of limitation, Applicant respectfully submits that Arima does not disclose any packaging station, or automatically housing the stacked film units into a film pack, as recited in independent claim 25. Applicant respectfully submits that the division sheets 10 are merely dividers between stacks of sheets, and cannot be properly construed as placing film units into a film pack, as recited in independent claim 25, because they do not disclose, teach or suggest the recited structure of the film pack.

Further, Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to combine Arima and McCole to produce the claimed combination of

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features. As noted above, neither reference, individually or applied together, discloses or suggests a packaging station where stacked film units are automatically housed into a film pack, as recited in claim 25. Applicant respectfully submits that only the specification of the presently claimed invention provides sufficient motivation for one skilled in the art to combine and/or modify the references to produce the claimed combinations of features. Applicant respectfully submits that without impermissible hindsight reconstruction based on the present application, one skilled in the art would not have been motivated to produce the claimed features. Thus, Applicant submits that the combination is improper, and requests withdrawal thereof.

Claims 26-29 depend from independent claim 25. Applicant respectfully submits that dependent claims 26-29 are allowable for at least the same reasons as discussed above with respect to independent claim 25. Additionally, Applicant respectfully submits that the Examiner's proposed combination of references fails to disclose or suggest a beveling station for beveling corners of said instant photography film unit, as recited in dependent claim 39. Thus, Applicant respectfully requests withdrawal of the rejections, and allowance of the claims.

B. Claims 30-36

Shimizu should be disqualified as a reference due to the common ownership between Shimizu and the present application at the time of the invention.

Applicant believes that the requirements have been met under the MPEP § 706.02(l), Applicant submits herewith additional evidence supporting removal of Shimizu as a rejecting reference. Applicant refers the Examiner to MPEP § 706.02(l), Section II, which states that a statement such as "Application X and Patent A were, at the time the invention of Application X

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was made, owned by Company Z" alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. § 103(a) against the claims of Application X. Applicant submits that the foregoing requirements have been met.

As proof of ownership by a common entity, Applicant submits Assignment information associated with the Shimizu reference in the attached Appendix. Applicant notes that the requirements of 35 U.S.C. § 103(c) have been met. For example, but not by way of limitation, Applicant respectfully submits that Shimizu is only available as prior art under 35 U.S.C. § 102(e) in a §103(a) rejection, and that the present invention has a filing date of July 2, 2001 (based on a parent application filed on June 30, 2000, with U.S. Application No. 09/609,245, now U.S. Patent No. 6,287,744), which is after November 29, 1999.

Also, Applicant respectfully submits that the present application and Shimizu were, at the time the invention the present application was made, owned by Fuji Photo Film Co., Ltd.. Thus, the present application qualifies for the application of 35 U.S.C. § 103(c).

The Shimizu reference (U.S. Serial No. 08/924,138) was filed on September 5, 1997, and the U.S. Patent and Trademark Office previously recorded the Assignment to Fuji Photo Film Co., Ltd. as of October 25, 1993, on Reel 6810 at Frame 0119.

Correspondingly, in the present application, the Assignment was recorded the Assignment to Fuji Photo Film Co., Ltd. as of June 30, 2000, on Reel 10939 at Frame 0932, in the parent of the present Divisional application (i.e., U.S. Application No. 09/609,245 and U.S. Patent No. 6,287,744).

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However, even if the Shimizu reference could be applied under 35 U.S.C. § 103, Applicant respectfully submits that the proposed combination of references fails to suggest all of the claimed combinations of features for at least the reasons herein.

Shimizu discloses a method for assembling photographic film, and a film cassette. At column 9, lines 10-32, Shimizu discloses buffer portions 35, 37 that reserve a certain amount of the loop, which can be longer than the interval of the image frame exposure area.

Applicant respectfully submits that the Examiner's proposed combination of references fails to disclose or suggest all of the claimed combination of features. For example, but not by way of limitation, Applicant respectfully submits that the proposed combination of McCole and Shimizu fails to suggest at least one free loop disposed in a feed region required to position said continuous member, as recited in independent claim 30. As acknowledged by the Examiner, McCole fails to disclose or suggest this claimed feature.

Applicant respectfully submits that the proposed combination of Shimizu into McCole fails to cure this acknowledged deficiency of McCole. However, Applicant respectfully submits that the Examiner's proposed combination is improper for at least the reasons herein, and thus should be withdrawn.

Applicant respectfully submits that McCole and Shimizu teach away from each other. Applicant notes that McCole teaches the processing of a single sheet at a time, with no slack at all. On the other hand, the Examiner has characterized Shimizu as teaching that buffer portions 35, 37 exist, to provide slack for the continuous sheet. As a result, it is submitted that McCole and Shimizu teach opposite principles of operation, such that one skilled in the art would not be

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motivated to combine the two references. Thus, it is submitted that the combination is improper, and should be withdrawn for at least the reasons herein.

Additionally, Applicant respectfully submits that even if one skilled in the art would have been motivated to combine the references, the combination would not have operated according to the claimed invention, because all of the parts of McCole operate at the same speed, whereas the buffer 35, 37 created by Shimizu would require operation at different speeds so that the film could be fed a plurality of pitches at a time. As a result, the functionality of McCole would be destroyed by altering the speed of various parts.

Also, Applicant respectfully submits that one of ordinary skill in the art would not have been motivated to combine Arima and Shimizu to produce the claimed combination of features. Applicant respectfully submits that only the specification of the presently claimed invention provides sufficient motivation for one skilled in the art to combine and/or modify the references to produce the claimed combinations of features. Applicant respectfully submits that without impermissible hindsight reconstruction based on the present application, one skilled in the art would not have been motivated to produce the claimed features. Thus, Applicant submits that the combination is improper, and requests withdrawal thereof.

Claims 31-36 depend from independent claim 30. Applicant respectfully submits that dependent claims 31-36 are allowable for at least the same reasons as discussed above with respect to independent claim 30. Additionally, Applicant respectfully submits that the Examiner's proposed combination of references fails to suggest detecting means disposed downstream of said free loop for detecting a positioned area of said continuous member and

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feeding said continuous member a predetermined number of pitches at a time with said second feed means based on the detected positioned area as recited in claim 32, or a beveling station for beveling corners of said instant photography film unit, as recited in claim 34. Thus, Applicant respectfully requests withdrawal of the rejections, and allowance of the claims.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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